

AMENDMENTS TO THE CLAIMS**MARKED-UP VERSION**

Please amend the following claims, namely claims 3 and 37-58, shown below in a "marked-up version":

3. (Once Amended) A device as in claim [2]1 further comprising a block positioned for insertion through all of the receptacle and for engagement with the mounting member.
37. (Once Amended) A device for use with a storage compartment for a vehicle having a receptacle [for holding], and for use with a trailer hitch mounting apparatus, the mounting apparatus having a male trailer hitch mounting member, the [storage compartment]device comprising:
- a mounting portion connected to the storage compartment; and
 - a trailer hitch mounting portion receptacle, connected to the mounting portion.
38. (Once Amended) A device [storage compartment] as in claim 37 further comprising a block positioned for insertion through at least a portion of the receptacle and for engagement with the mounting member.
39. (Once Amended) A device [storage compartment] as in claim [38]37 further comprising a block positioned for insertion through all of the receptacle and for engagement with the mounting member.

40. (Once Amended) A device [storage compartment] as in claim 37 further comprising a friction member connected to the receptacle.
41. (Once Amended) A device [storage compartment] as in claim 37 further comprising threads positioned in the receptacle to engage the mounting member.
42. (Once Amended) A device [storage compartment] as in claim 37 wherein said mounting portion is fixed to the trailer hitch mounting portion receptacle.
43. (Once Amended) A device [storage compartment] as in claim 37 wherein said mounting portion is movably attached to the trailer hitch mounting portion receptacle.
44. (Once Amended) A device [storage compartment] as in claim 43 wherein said mounting portion is pivotally attached to the trailer hitch mounting portion receptacle.
45. (Once Amended) A device [storage compartment] as in claim 37 wherein said mounting portion comprises a substantially flat member.
46. (Once Amended) A device [storage compartment] as in claim 45 wherein said mounting portion further includes mounting holes therein.
47. (Once Amended) A device [storage compartment] as in claim 45 wherein said mounting portion further includes mounting cylinders connected thereto.

48. (Once Amended) A device [storage compartment] as in claim 47 wherein said mounting cylinders comprise bolts.

49. (Once Amended) A device [storage compartment] as in claim 48 wherein said bolts are threadedly connected to said mounting portion.

50. (Once Amended) A device [storage compartment] as in claim 48 wherein said bolts are integrally connected to said mounting portion.

51. (Once Amended) A device [storage compartment] as in claim 50 wherein said bolts are welded to said mounting portion.

52. (Once Amended) A device [storage compartment] as in claim 47 wherein said mounting cylinders comprise pins.

53. (Once Amended) A device [storage compartment] as in claim 52 wherein said pins are threadedly connected to said mounting portion.

54. (Once Amended) A device [storage compartment] as in claim 52 wherein said pins are integrally connected to said mounting portion.

55. (Once Amended) A device [storage compartment] as in claim 54 wherein said pins are welded to said mounting portion.

56. (Once Amended) A device [storage compartment] as in claim 54 wherein said pins are cast with said mounting portion.

57. (Once Amended) A device [storage compartment] as in claim 37 wherein said mounting portion is integrally formed with a wall of the storage compartment.

58. (Once Amended) A device [storage compartment] as in claim 37 wherein said mounting portion is connected to a wall of the storage compartment.

PARAGRAPH 1, 2**EXAMINER WITHDRAWS RESTRICTION REQUIREMENT.**

Applicant acknowledges and appreciates the Examiner withdrawing the restriction requirement in light of Applicant's response to the restriction requirement mailed January 3, 2001.

PARAGRAPH 3**APPLICANT'S DRAWINGS SHOW APPLICANT'S INVENTION.**

The drawings stand objected to as being replete with errors under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims. Specifically, the Office Action cites the following excerpt from Applicant's claim 5 as not illustrated by the drawings: "threads positioned to engage the mounting member." Applicant respectfully submits the following discussion having reasons for disagreeing with this 37 CFR 1.83(a) objection.

On page 4 under Brief Description of the Drawings, the application states, "Figure 7 is a side view of a trailer hitch mounting portion receptacle ready to threadedly mate with a male trailer hitch mounting member." Further, in the last paragraph on page 10, the application states, "In the Figure [7], threads 50' of the mail trailer hitch mounting member 18 provide a method and means to engage threads 50 of receptacle 22." Applicant submits that the Brief Description of the Drawing, Figure 7, and the excerpt on page 10 from the Detailed Description of Example Embodiments of the Invention provide ample support for and illustrate claim 5. In light of this discussion and the application as a whole, Applicant

respectfully requests reconsideration and withdrawal of the objection to the drawings under 37 CFR 1.83(a).

PARAGRAPHS 4, 5

THE SPECIFICATION ENABLES CLAIMS 11-20.

Claims 11-20 stand rejected under § 112, ¶ 1 as containing subject matter not described in a manner enabling one of ordinary skill in the art to make and or use the invention. Specifically, the Office Action states, "In claim 11, it is not known how the cylinders mount to the mounting portion." Applicant respectfully submits the following discussion having reasons for disagreeing with this § 112, ¶ 1 rejection.

Apparatus claim 11 claims that the mounting portion of Applicant's invention "further includes mounting cylinders connected thereto." Attributing literal meanings to the words in claim 11 reveals that claim 11 claims that "mounting cylinders" mount the mounting portion to a substrate. Claims 12-20 further clarify and claim embodiments dependent on claim 11. Claim 12 claims that the "mounting cylinders" are "bolts", and claims 13 and 14 respectively claim that the bolts are "threadedly connected" (i.e., a screw type bolt) or "integrally connected" to the mounting portion. Further, claim 15 claims "integrally connecting" comprises a "welded" connection.

Claims 16-19 closely parallel claims 12-15. Claim 16 claims that the mounting cylinders are "pins", and claims 17 and 18 respectively claim that the pins are "threadedly connected" (i.e., a screw type pin) or "integrally connected" to the mounting portion. Further, claim 19 claims "integrally connecting" comprises a "welded" connection. Further still, claim 20 claims that the pins are "cast" with the mounting portion.

Turning now the specification, a more enabling description of claims 11-20 found at page 8, line 17 and continuing through page 9, line 13 states:

In still another alternative embodiment, as seen in Figure 10b, flange 95a of tab 80a and flange 95b of tab 80b are connected to mounting portion 20 by, for example, mounting cylinders 90a-90f (as seen in Figure 11), which traverse flange holes 95a' and 95b' and at least two of bolt holes 86a-86f found in mounting portion 20.

It will also be noted that, in the preceding Figures, mounting portion 20 is a substantially flat member. In other embodiments of the invention, whether for device 5 or storage compartment 10 embodiments, mounting portion 20 is curved, for example, convex or concave, depending on the surface to which mounting portion 20 is to be connected. For example, in some embodiments, mounting portion 20 is connected to a garage wall or, alternatively, the wall of a dwelling or storage warehouse. Various methods for attaching mounting portion 20 will occur to those of skill in the art without departing from the spirit of the invention. In some embodiments, for example, mounting portion 20 includes bolt holes 86a-86f (Figure 10b). In an alternative embodiment, seen in Figure 11, mounting portion 20 includes mounting cylinders 90a-90f (for example, pins, bolts, etc.). In some embodiments, mounting cylinders 90a-90f are threadedly connected to mounting portion 20. In even further embodiments, mounting cylinders 90a-90f are welded to mounting portion 20, while, in still other embodiments, mounting cylinders 90a-90f are integrally formed with mounting portion 20, by, for example, casting, forging, or other methods that will occur to those of skill in the art.

In still a further embodiment, as seen in Figure 12, mounting portion 20 is placed behind a retaining structure 101, which includes an opening 103 through which receptacle 22 passes.

This excerpt from the specification includes and discusses every claim limitation found in claims 11-20, and specifically explains how the cylinders mount to the mounting portion. That is, the cylinders and pins are threadedly connected (e.g. a screw) through holes in the mounting portion to a substrate. Alternatively, the cylinders and pins are integrally connected (e.g., casting or forging) to the mounting portion to a substrate. Applicant respectfully submits that the specification enables one of ordinary skill to practice the invention as claimed in claims 11-20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112, ¶1 rejection.

PARAGRAPHS 6, 7A

AMENDED CLAIM 3 IS DEFINITE.

Claim 3 stands rejected under § 112, ¶ 2 as indefinite for failing to particularly point out and distinctly claim subject matter Applicant regards as the invention. Specifically, the Office Action states that it is unclear if "a block" in claim 3 is the same "block" as in claim 2. In response, Applicant submits a marked-up version of claim 3, shown above in the Amendments to the Claims section. Applicant also submits the following remarks and a clean version of amended claim 3.

Claim 3 claims the same embodiment as amended claim 3, but amended claim 3 claims the embodiment more definitely. Amended claim 3 claims an embodiment of the invention wherein the block is positioned for insertion through *all* of the receptacle, i.e., for traversing the entire width of the receptacle, and for engagement with the mounting member. Visually, Figure 5 shows the block positioned for traversing the entire width of the receptacle, wherein the mounting member is inserted into the receptacle. With the mounting member inserted into the receptacle, the block is positioned to traverse through the aligned holes of the receptacle and the mounting member. By comparison, claim 2 claims all embodiments in which the block is positioned for insertion through *less than all* of the receptacle, i.e., for traversing only a *portion* of the entire width of the receptacle. Referring to Figure 6, if the mounting member is inserted into the receptacle, then claim 2 claims embodiments of the invention wherein the block traverses, for example, half-way or three-quarters, through the width of the receptacle, i.e., only through holes 18a and 22a. See also page 7, lines 9-11. That is, claim 2 does not claim claim 3's positioning of the block that requires *all of the block* to traverse the entire width of the receptacle. Accordingly, in light of this discussion and proposed amendment, Applicant respectfully requests reconsideration and withdrawal of the

the receptacle' since its block may not go through the sides of the receptacle." Applicant submits the following remarks and a marked-up version of claim 39, shown above in the Amendments to the Claims section. Applicant further submits that Applicant's position under this rejection is the same as Applicant's position under the response to § 112, ¶ 2 rejection of claim 3.

Claim 39 claims the same embodiment as amended claim 39, but amended claim 39 claims the embodiment more definitely. Amended claim 39 claims an embodiment of the invention wherein a storage compartment has a block positioned for insertion through all of the receptacle, i.e., for traversing the entire width of the receptacle, and for engagement with the mounting member. Figures 4a and 4b show the storage compartment and viewed with Figure 5, Figure 5 shows the block positioned for traversing the entire width of the receptacle, wherein the mounting member is inserted into the receptacle. With the mounting member inserted into the receptacle, the block is positioned to traverse through the aligned holes of the receptacle and the mounting member. By comparison, claim 38 claims all embodiments in which the block is positioned for insertion through *less than* all of the receptacle, i.e., for traversing only a *portion* of the entire width of the receptacle. Referring to Figure 6, if the mounting member is inserted into the receptacle, then claim 38 claims embodiments of the invention wherein the block traverses, for example, half-way or three-quarters, through the width of the receptacle, i.e., only through holes 18a and 22a. See also page 7, lines 9-11. That is, claim 38 does not claim claim 39's positioning of the block that requires *all of the block* to traverse the entire width of the receptacle. Accordingly, in light of this discussion and proposed amendment, Applicant respectfully requests reconsideration and withdrawal of the objection to the § 112, ¶ 2 rejection and entry of amended claim 39, as shown above in the Amendments to the Claims section of this Response.

PARAGRAPHS 8 – 10**APPLICANT'S INVENTION IS NOVEL IN VIEW OF KLEMETSEN.**

Claims 1-7, 9, 10, 47-43 and 45-56 stand rejected under § 102(b) as being anticipated by United States patent 5,476,297 issued to Klemetsen ("Klemetsen"). Applicant respectfully disagrees and submits the following discussion having reasons and showing that Applicant's invention is novel in light of Klemetsen.

A claim lacks novelty if every limitation is found in a single piece of prior art. *Kraft Foods, Inc. v. International Trading Co.*, 203 F.3d 1362, 1370 (Fed. Cir. 2000). Further, the anticipating piece of prior art must show the invention in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicant's claims 1 and 37, as amended, are novel because Klemetsen does not embody every limitation found in claims 1 or 37, and any Klemetsen teachings of the limitations in claims 1 and 37 are not in as complete detail as contained in claims 1 and 37. Upon closer review of Klemetsen, it is immediately apparent that Klemetsen and Applicant's inventions fundamentally differ in that nowhere does Klemetsen disclose or claim a device (for storing a trailer hitch apparatus) or a device (for use with a storage compartment). Instead, Klemetsen discloses and claims a trailer hitch for towing cars. X use

Another difference between Klemetsen's and Applicant's inventions is that Klemetsen does not disclose "a mounting portion". Construing Applicant's claim language in light of his specification, Applicant discloses and claims a "mounting portion", connected in many different ways, to a trailer hitch mounting portion receptacle. Nowhere does Klemetsen disclose or claim "a mounting portion" – an element of Applicant's independent claims 1 and 37, as amended. Further, the Klemetsen figures also fail to disclose a "mounting portion",

and when compared to Applicant's figures, it is even more apparent that Klemetsen and Applicant are truly claiming and disclosing different inventions.

Still another difference is that Klemetsen does not disclose or claim "a trailer hitch mounting portion receptacle, connected to the mounting portion." Obviously, if Klemetsen does not disclose or claim a "mounting portion", then Klemetsen cannot disclose or claim Applicant's second claim element's limitation of being connected to the mounting portion.

In sum, the discussion above shows that Klemetsen does not anticipate Applicant's independent claims 1 and 37, as amended. Further, Applicant respectfully points out that if independent claims 1 and 37 are allowable, then Applicant's claims 2-7, 9, 10, 36-43, 45, and 46, as amended and also under rejection, are not barred because these dependent claims stand with the independent claims. In *re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests reconsideration and withdraw of the § 102(b) rejection because Applicant's invention is novel.

PARAGRAPHS 11, 12, 13 & 15

KLEMETSEN, FRANCISCO, AND HOWELL ARE NOT ANALOGOUS ART.

In order to rely on a reference as a basis for rejection of Applicant's invention, the reference must either be in the field of the Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In *re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). *Oetiker* is the leading case regarding nonanalogous art. The applicant in *Oetiker* claimed an improvement in a hose clamp that differed from the prior art in the presence of a preassembly hook that maintained the preassembly conditions of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference that disclosed a hook and eye fastener for use in garments, reasoning that all

hooking problems are analogous. The Federal Court held that the reference was not within the field of the applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. *Id.*, at 1447.

In the present case, Applicant claims devices, method, and a system for storing trailer hitch apparatuses. The Office Action cites three references, Klemetsen, Francisco, and Howell ("the three patents"). Klemetsen and Francisco, in general, both disclose trailer hitches for towing vehicles. Howell discloses a vehicle storage box. None of the three patents disclose or claim a device, method, or a system for storing trailer hitch apparatuses. In Applicant's case, just as in *Oetiker*, there is no showing whatsoever that a person of ordinary skill, seeking to solve the problem of storing trailer hitch apparatuses would reasonably be expected or motivated to look to devices for towing vehicles or vehicle storage boxes.

The Office Action at paragraphs 12, 13 and 15 states that a person of ordinary skill in the art would conclude that it would be obvious to modify Klemetsen itself or Klemetsen in view of Francisco or Howell to render Applicant's invention obvious. Crucial to note, however, is that the present invention is not directed towards inventions for towing vehicles or vehicle storage boxes as with the three patents. The present invention claims devices, a method, and a system for storing trailer hitch apparatuses, an invention that is therefore nonanalogous to the disclosures in the three patents.

If it were correct that Klemetsen and Francisco, and to a much lesser extent Howell, are analogous to the present invention merely on account of being analogous to one another, then we would see a complete end to invention in the area of trailer hitches because Klemetsen and Francisco would, in the analysis of the Office Action, preempt the entire field of trailer

hitch inventions. Such a position is what *Oetiker* prohibits, that is, parallel to the Board's position overruled in *Oetiker* that all hooking problems are analogous.

In all of the following discussion in this Response, Applicant reserves the position that the three patents are not available as a reference against Applicant's invention because the three patents are nonanalogous art.

PARAGRAPHS 11 & 12

APPLICANT'S INVENTION IS NOT OBVIOUS IN VIEW OF KLEMETSEN.

Claims 11-20 and 47-56 stand rejected under § 103(a) as being unpatentable over Klemetsen. Applicant agrees with the Office Action's position that Klemetsen does not disclose cylinders as claimed in claim 11 to which claims 12-20 directly or indirectly depend, and as claimed in claim 47, to which claims 48-56 directly or indirectly depend. The Office Action states, however, that in conjunction with the discussion above (presumably under paragraphs 8-10 of the Office Action), it would have been obvious to modify Klemetsen to include cylinders as bolts and pins threadedly connecting the mounting portion. Applicant respectfully submits the following discussion having reasons for disagreeing with this § 103(a) rejection.

The *prima facie* case of obviousness requires: 1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, 2) that references possess a reasonable expectation of success in the modification or combination, and 3) that references must teach or suggest all of Applicant's claim limitations. MPEP § 2142; *In re Vaack*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). *Prima facie* obviousness is to be determined according to whether the claimed invention as a whole would have been obvious, and not whether the differences between the prior art and the claimed invention would have been obvious. *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995); MPEP 2141.02. In addition, the *prima facie* case is

not to be founded on hindsight, or as the court said in *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, "to imbue one of ordinary skill in the art with knowledge of the Applicant's invention, when the prior art does not teach or suggest the relevant knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher," i.e., the inventor. *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

The rule for obviousness, stated above, makes clear that Klemetsen does not render Applicant's invention, in particular claims 11-20 and 47-56, obvious. First, no showing exists in Klemetsen or of why it is within the knowledge of one skilled in the art to modify Klemetsen and render Applicant's invention obvious. As discussed above under paragraphs 8-10, Klemetsen does not disclose a mounting portion or a mounting portion connected to a trailer hitch mounting portion receptacle. Further, the Office Action admits that Klemetsen does not claim or disclose cylinders in dependent claims 11-20 and 47-56. Further still, Klemetsen discloses an invention relating to towing vehicles rather than storing trailer hitch apparatuses. Thus, it is apparent that Klemetsen does not meet the first of three obviousness criteria, and closer analysis reveals that Klemetsen, in fact, does not meet any of the three obviousness criteria.

Under the second criterion, there is no reasonable expectation of success in modifying Klemetsen because there is no suggestion to modify Klemetsen. Further, Klemetsen differs from Applicant's invention in more ways than the cylinders as the Office Action suggests. These differences are apparent in Klemetsen's failure to meet the third criterion of teaching or suggesting all of Applicant's claim limitations. As shown above, not only does Klemetsen fail to teach or suggest "cylinders" as found directly or indirectly in claims 11-20 and 47-56, but Klemetsen fails to teach or suggest "a mounting portion" and "a trailer hitch mounting portion receptacle connected to the mounting portion" found in independent claims 1 and 37, as amended. Accordingly, Applicant respectfully requests reconsideration and withdraw of the § 103(a) rejection because Applicant's invention is nonobvious in view of Klemetsen.

PARAGRAPHS 11 & 13**APPLICANT'S INVENTION IS NOT OBVIOUS IN VIEW OF KLEMETSEN AND FRANCISCO.**

Claims 8 and 44 stand rejected under § 103(a) as being unpatentable over Klemetsen in view of U.S. patent 4,991,865 issued to Thomas E. Francisco ("Francisco"). The Office Action states that in conjunction with the discussion above (presumably under paragraphs 8-10 of the Office Action) "Francisco teaches using a mounting portion pivotally attached mounting receptacle to allow the vehicle and trailer to be further apart during hitching." The Office Action further states that it would have been obvious to modify Klemetsen as taught by Francisco to include the mounting portion being pivotally attached to the receptacle. Applicant respectfully submits the following discussion having reasons for disagreeing with this § 103(a) rejection.

Applying the three-pronged rule for obviousness stated above in the discussion under Paragraphs 11 & 12, Klemetsen in view of Francisco fails to render Applicant's invention, in particular claims 8 and 44, obvious. First, no showing exists in Klemetsen or of why it is within the knowledge of one skilled in the art to modify Klemetsen with pivoting teachings from Francisco to render Applicant's invention obvious. As discussed above under paragraphs 8-10, Klemetsen does not disclose a mounting portion or a mounting portion connected to a trailer hitch mounting portion receptacle. Further, Francisco's discussion of pivoting relates to towing of vehicles, specifically pivotally attaching a second end of a hitch assembly to a towed vehicle. Further still, Francisco's teaching of pivoting relates to a telescoping member and is for a device for attaching one of two ends to a trailer and the other to a vehicle for towing the trailer. In short, Klemetsen and Francisco both disclose inventions relating to towing vehicles rather than storing trailer hitch apparatuses. Thus, it is apparent that Klemetsen even in view of Francisco does not meet the first of three obviousness criteria, and closer analysis reveals that Klemetsen in view of Francisco does not meet the other two obviousness criteria either.

Under the second criterion, there is no reasonable expectation of success in modifying Klemetsen in view of Francisco because there no suggestion exists anywhere to modify Klemetsen with Francisco. Further, Klemetsen and Francisco fail to meet the third criterion of teaching or suggesting all of Applicant's claim limitations. Klemetsen in view of Francisco fails to teach or suggest "mounting portion is pivotally attached to the trailer hitch mounting portion receptacle" as found in claims 8 and 44. Moreover, Klemetsen in view of Francisco also still fails to teach or suggest "a mounting portion" and "a trailer hitch mounting portion receptacle connected to the mounting portion" found in independent claims 1 and 37, as amended. Accordingly, Applicant respectfully requests reconsideration and withdraw of the § 103(a) rejection because Applicant's invention is nonobvious in view of Klemetsen and Francisco.

PARAGRAPHS 11 & 14

**APPLICANT'S INVENTION IS NOT OBVIOUS IN VIEW OF KLEMETSEN
AND APPLICANT'S RESTRICTED REQUIREMENT RESPONSE.**

Claims 21-36 stand "rejected under § 103(a) as being unpatentable in view of Klemetsen and Applicant's admission that 'the inventions are not patentably distinct.'" Applicant respectfully submits the following discussion having reasons for disagreeing with this § 103(a) rejection.

Applicant reasserts that the method and system claims, i.e., claims 21-36, are not patentably distinct from Applicant's claimed invention, and in view of the rule for obviousness, stated above, it is clear that Klemetsen in view of Applicant's admission still does not render Applicant's claims 21-36 obvious. As with the obviousness rejection directed to Klemetsen under Paragraphs 11 & 12 of the Office Action, no showing exists in Klemetsen in view of Applicant's admission of why Applicant's claims 21-36 are obvious. Klemetsen does not disclose "receiving" or a "means for receiving a member into a receptacle, the receptacle

being connected to a storage location." Further, Klemetsen does not disclose "limiting" or a "means for limiting reciprocation between a member and the receptacle" as claimed in Applicant's invention, specifically independent claims 21 and 29. Thus, it is apparent that Klemetsen in view of Applicant's admission does not meet the first of three obviousness criteria, and closer analysis reveals that Klemetsen in view of Applicant's admission does not meet any of the three obviousness criteria.

Under the second criterion, there is no reasonable expectation of success in modifying Klemetsen because there is no suggestion to modify Klemetsen in view of Applicant's admission. Further, Klemetsen in view of Applicant's admission fails to meet the third criterion of teaching or suggesting all of Applicant's claim limitations. As shown above, not only does Klemetsen fail to teach or suggest "receiving" or a "means for receiving a member into a receptacle, the receptacle being connected to a storage location" as found directly or indirectly in claims 21-28 and 29-36, respectively, but Klemetsen in view of Applicant's admission also fails to teach or suggest "limiting" or a "means for limiting reciprocation between a member and the receptacle" as found directly or indirectly in claims 21-28 and 29-36, respectively. Accordingly, Applicant respectfully requests reconsideration and withdraw of the § 103(a) rejection because Applicant's invention is nonobvious in view of Klemetsen and Applicant's admission.

PARAGRAPHS 11 & 15

APPLICANT'S INVENTION IS NOT OBVIOUS IN VIEW OF KLEMETSEN AND HOWELL.

Claims 57 and 58 stand rejected under § 103(a) as being unpatentable over Klemetsen in view of U.S. patent 6,170,723 issued to Brian Dodd Howell ("Howell"). The Office Action states that in conjunction with the discussion above (presumably under paragraphs 8-10 of the Office Action) "Howell [teaches?] a storage compartment to store objects." The Office Action further

states that it would have been obvious to modify Klemetsen as taught by Howell to include the mounting portion integrally formed with a wall of a storage compartment. Applicant respectfully submits the following discussion having reasons for disagreeing with this § 103(a) rejection.

Applying the three-pronged rule for obviousness stated above in the discussion under Paragraphs 11 & 12, Klemetsen in view of Howell fails to render Applicant's invention, in particular claims 57 and 58, obvious. First, no showing exists in Klemetsen or Howell of why it is within the knowledge of one skilled in the art to modify Klemetsen with the storage compartment claimed and disclosed in Howell and thereby render Applicant's invention obvious. As discussed above under paragraphs 8-10, Klemetsen does not disclose a mounting portion or a mounting portion connected to a trailer hitch mounting portion receptacle. Further, Howell's teaching of a truck storage box with patentable emphasis seemingly on the lids has no relation to claims 58 and 59, as amended. That is, claims 58 and 59 relate to a device for use with a storage compartment. In short, Klemetsen's disclosure of an invention relating to towing vehicles and Howell's disclosure of an invention relating to a vehicle storage compartment do not combine to render Applicant's invention obvious. Thus, it is apparent that Klemetsen even in view of Howell does not meet the first of three obviousness criteria, and closer analysis reveals that Klemetsen in view of Howell does not meet the other two obviousness criteria either.

Under the second criterion, there is no reasonable expectation of success in modifying Klemetsen in view of Howell because there no suggestion exists anywhere to modify Klemetsen with Howell. Further, Klemetsen and Howell fail to meet the third criterion of teaching or suggesting all of Applicant's claim limitations. Klemetsen in view of Howell fails to teach or suggest the mounting portion being integrally formed or connected to the wall of the storage compartment as found in claims 57 and 58, respectively. Moreover, Klemetsen in view of Howell also still fails to teach or suggest "a mounting portion" and "a trailer hitch mounting portion receptacle connected to the mounting portion" found in independent claim 37, as

amended. Accordingly, Applicant respectfully requests reconsideration and withdraw of the § 103(a) rejection because Applicant's invention is nonobvious in view of Klemetsen and Howell.

PARAGRAPH 16

APPLICANT'S ACKNOWLEDGES EXAMINER'S POSITION OF ADDITIONAL PRIOR ART.

Applicant acknowledges examiner's position that the following patents, although not relied upon, are considered pertinent to Applicant's disclosure: Ludwick (U.S. 5,738,632); Kravitz (U.S. 5,735,539); McCoy (U.S. D 376,780); Wilson (U.S. 5,464,264); Carsten (U.S. 5,322,315); Blaser (U.S. 5,277,447) Nichols (U.S. 2,637,566); and Stimac (U.S. 5,845,921).

CONCLUSION


Applicant proposes that the claimed invention is novel in light of Klemetsen. Further, Applicant proposes that Klemetsen, Francisco, Howell, Applicant's admission, official notice or knowledge available to one of ordinary skill in the art at the time the invention was made, alone or in combination, does not render the claimed invention obvious.

Applicant believes that the present application, as amended and in view of the discussion in this Response, is in condition for allowance. An early notice of allowance is respectfully requested.

Should Examiner have any need to contact Applicant at any time, he is invited to phone Applicant's attorney, Erik J. Osterrieder, at any time to discuss the claims and ensure the present application is in condition for allowance.

Respectfully submitted,

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